

### **Remarks**

Claims 75-145 were pending in the application. Claims 75, 83, 85-86, 91, 95, 96, 106, 109, 116, 118, 119, 124 and 127-128 have been amended. New claims 146-152 have been added. Claims 76, 80, 82, 97, 110, 113 and 132 have been canceled. Claims 1-74 were previously canceled.

Applicant certainly appreciates the indication of allowable subject matter with respect to claims 86-88 and 118-121.

Applicant further appreciates the courteous assistance given by the Examiner in the phone interview of October 23, 2006. Pursuant to the phone discussions, Applicant is filing the present amendment and response.

Applicant would further point out that claims 128-145 were not considered in the Office Action of August 7, 2006. These claims were presented in the amendment accompanying the Request for Continued Examination filed on July 10, 2006.

In considering the claims now presented, Applicant would have the Examiner consider the remarks that follow:

#### **I. Removal of Claim Limitations**

Applicant has amended independent claims 75, 96 and 109 to remove reference to a specific coupling and to define that the back inliner is coupled to the sole inliner. As discussed with the Examiner over the phone, the recitation of a separate coupling is believed to be unnecessary. Reference to a coupling has also been removed from dependent claims 83, 85, 91, 95, 106, 116 and 124, and claims 76, 97 and 110, which referred to a coupling, have been canceled.

#### **II. Rejections Under 35 U.S.C. §102(e)/ §103 Based on Townsend et al.**

The Examiner had previously rejected claims as being anticipated under 35 U.S.C. §102(e) or as being obvious under §103(a), based upon the reference Townsend et al. (U.S. Patent No. 6,692,454) alone or in combination with McDonald (U.S. Patent No. 5,319,869) or Aveni (U.S. Patent No. 5,467,537).

An invention is said to be “anticipated” only if each and every element set forth in the claim is found, either expressly or inherently, within a single prior art reference.

*Verdegall Bros. V. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP 2143.03. Applicant respectfully submits that the Townsend et al. reference, either alone or in combination with McDonald or Aveni, fails to disclose each and every element of Applicant's claimed invention and thus fails to anticipate or provide a *prima facie* case of obviousness of Applicant's presently pending claims.

Applicant's claimed invention is for a shoe that has a support system for supporting the ankle of a foot. The shoe support system is used to facilitate prevention of inversion and eversion movement of the ankle, which can lead to serious injury. The support system is particularly useful in athletic shoes of various types and may replace the athletic tape or "spatting" that is wrapped around the ankle and shoe to provide support. Because the support system is incorporated into a common shoe used for walking, running, etc., it is lightweight, compact and non-obtrusive.

Townsend et al. is directed toward a shoe and ankle orthosis for protecting the ankle against injury. In contrast to Applicant's invention, the device of Townsend et al. not only limits certain movements, but also applies force and promotes or encourages certain movements of the foot that are not found in Applicant's invention. Applicant's back inliner is configured for the back of the foot and does not apply or encourage specific turning or motion of the foot or ankle, as in Townsend et al. As can be seen from the figures of Applicant's specification, more specifically, Figures 7A and 7B, the back inliner 160 extends upward along the back of the foot only. There is no turning or twisting of the back inliner that would apply any torsional forces, as in Townsend et al. More particularly, the back inliner does not have any forward projecting wings, such as the wings 22, 23 of Townsend et al., which would necessarily apply torsional forces to the leg or ankle.

Applicant would point out that the Examiner has referred to the specific embodiment of Figures 22-25. The description of Townsend et al. for the other embodiments, however, have application to that of Figures 22-25, as well. In particular, the embodiments of the device of Townsend et al. each utilize a strut 20 (Figs. 13A-13D)

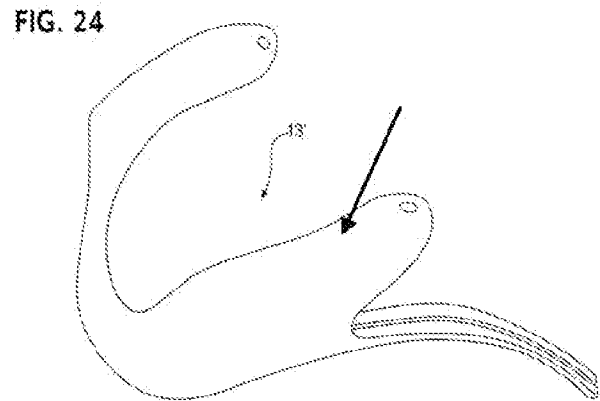
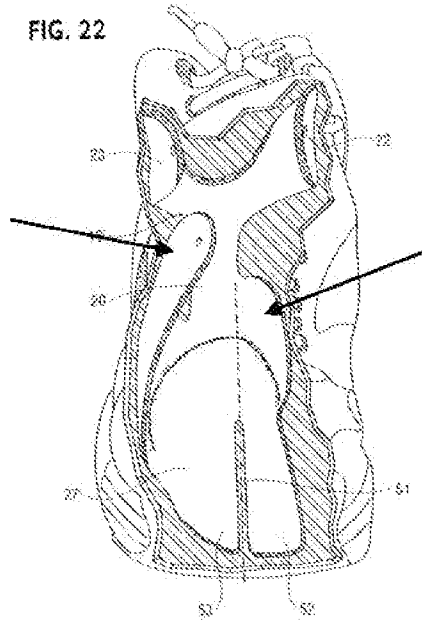
that extends from the heel to an upper end where forward projecting wings 22, 23 are provided for securing to the lower leg. This is described, for instance, at column 17, lines 4, etc. Moreover, it is described in Townsend et al. that the strut 20 serves as a torsion bar that encourages motion (*see* Figure 13E) about the ankle joint axis. This motion would necessarily be imparted by the wings 22, 23, as well as the strut 20. It is further described how the strut 20, which serves as the torsion bar, is manufactured, by heating and twisting the material of the strut at one position in a counter clockwise direction 23°, and then heating and twisting the material 1½ inch above this 17° in an opposite clockwise direction. This is described at column 17, lines 19-24.

Independent claims 75, 96, 109 and 128 have been specifically amended to define that the back inliner does not project forward of the ankle, as do the wings 22, 23 of Townsend et al. This is supported in the application as filed, as the back inliner 160 is described as generally conforming to the back of the foot, namely the Achilles tendon (*see* page 15, lines 26-27 and Figures). Independent claims 75, 96, 109 and 128, should therefore be allowed for at least this reason.

Those claims depending from claims independent claims 75, 96, 109 and 128 should also be allowed as depending upon an allowable base claim.

Applicant has also added new dependent claims 146-149, which are dependent upon independent claims 75, 96, 109 and 128, respectively, to further define that the back inliner and sole inliner do not extend over the sides of the foot. As described at page 15, lines 25-26, the sole inliner 120 is configured to conform to the sole of the foot. Applicant would particularly point out the embodiments of Figures 7A and 7B of the specification, which clearly illustrate this. As shown, the sole inliner is not configured and does not extend over the side of the foot, as in Townsend et al.

Referring to the Figures 22 and 24 of Townsend et al., as set forth below, the sole inliner 52, 53, which the Examiner refers to, has significant structure as indicated by the arrows, that extends over both sides of the foot. This applies pressure to the sides of the foot, which is not present in Applicant's invention. Claims 146-149 should therefore be allowed for this additional reason.



New dependent claims 150-152 have also been added. These claims are dependent upon independent claims 94, 109 and 128, respectively, and each call for the relative movability of the back inliner and sole inliner to be facilitated by a hinge. This is not shown, taught or suggested by Townsend et al. These claims should be allowed for this additional reason.

### **III. Conclusion**

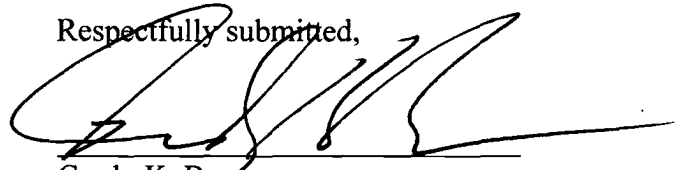
In view of all of the reasons presented above, Applicant submits that the application is in a condition for allowance. Favorable action is therefore respectfully requested.

If any further extension of time is believed necessary such extension is hereby by requested. If any fees are deemed necessary for the continued prosecution of the present application, the Commissioner is hereby authorized to charge them to Deposit Account No. 50-1899.

Please contact the undersigned at the address or telephone number listed below should there be any questions, or if contacting the undersigned would expedite or aid the examination or prosecution of this application.

Date: November 7, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Grady K. Bergen', written over a horizontal line.

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